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In re Application of WHITLEY et al
U.S. Application No.: 09/647,028
Int. Application No.: PCT/US99/06429
Int. Filing Date: 24 March 1999
Priority Date: 24 March 1998
Attorney Docket No.: 36968/176363
For: WIRELESS TELEMETRY METHODS AND
SYSTEMS FOR COMMUNICATING WITH
OR CONTROLLING INTELLIGENT DEVICES

DECISION

This is in response to the papers filed 25 September 2000, including a "Statement Regarding Lack of Signature of Applicant/Inventor Under PCT Rule 4.15(b)". The statement is being treated as a request to accept the application for United States national stage processing without the signature of two of the joint inventors and thus will be treated as a petition under 37 CFR 1.47(a).

BACKGROUND

On 24 March 1999, applicants filed international application PCT/US99/06429, which claimed priority of an earlier United States application filed 24 March 1998. A Demand for international preliminary examination, in which the United States was elected, was filed on 21 September 1999, prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 25 September 2000 (24 September 2000 was a Sunday).

On 25 September 2000, applicants filed national stage papers in the United States. The submission was accompanied by, *inter alia*, the basic national fee required by 35 U.S.C. 371(c)(1) and a declaration executed by one of the three joint inventors.

On 08 March 2001, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905) along with a Notification of a Defective Oath or Declaration (Form PCT/DO/EO/917), indicating that a properly executed oath or declaration in compliance with 37 CFR 1.497 must be filed along with a

surcharge under 37 CFR 1.492(e) for providing the oath or declaration later than thirty (30) months from the priority date.

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by: (1) an oath or declaration by each applicant on his or her own behalf and on behalf of the nonsigning joint inventors, (2) factual proof that the missing joint inventors refuse to join in the application or cannot be reached after diligent effort, (3) the fee set forth in §1.17(i), and (4) the last known addresses of the nonsigning joint inventors.

With regard to item (1) above, applicant has submitted a declaration signed by inventor Arthur Shand on his own behalf and on behalf of the nonsigning inventors Kevin Whitley and Karl Warfel.

With regard to item (2) above, MPEP 409.03(d) states in relevant part,

Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, an affidavit or declaration of facts should be submitted which fully describes the exact facts which are relied on to establish that a diligent effort was made. . . . The affidavit or declaration of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as certified mail return receipt, cover letter of instructions, telegrams, etc., that support a finding that the nonsigning inventor could not be found or reached should be made part of the affidavit or declaration. It is important that the affidavit or declaration contain statements of fact as opposed to conclusions.

* * *

Where a refusal to sign the application papers is alleged, the circumstances of this refusal must be specified in an affidavit or declaration by the person to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Before a refusal can be alleged, it must be demonstrated that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.

When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the affidavit or declaration. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the affidavit or declaration.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the affidavit or declaration. If there is documentary evidence to support facts alleged in the affidavit or declaration, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the affidavit or declaration.

In the present case, the petition states that good faith attempts were made to obtain the signatures of Whitley and Warfel. The petition states that it is accompanied by a copy of correspondence sent to Whitley and Warfel dated 05 May 1999 and by copies of return receipts which indicate receipt of the correspondence by the nonsigning inventors. Thus, it is unreasonable to conclude that Whitley and Warfel cannot be reached.

However, applicant has not demonstrated that Whitley and Warfel refuse to join in the application. Specifically, applicant has not shown that a bona fide attempt was made to present a complete copy of the application papers to Whitley and Warfel for signature. Although the 05 May 1999 letter states that PCT powers of attorney and assignment agreements were enclosed, the petition does not indicate that copies of the application papers (including specification, claims, drawings, and oath/declaration) were ever sent to the nonsigning inventors at their last known addresses. Furthermore, applicant has not provided details of any other attempts to contact Whitley and Warfel. Thus, it would not be appropriate to conclude at the present time that Whitley and Warfel refuse to join in the application.

With regard to item (3) above, applicant has not provided the requisite petition fee.

With regard to item (4) above, the petition does not state the last known addresses of the nonsigning inventors.

CONCLUSION

Because applicants have failed to satisfy items (2), (3), and (4) above, the petition under 37 CFR 1.47(a) is DISMISSED without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Failure to timely file a proper response will result in abandonment of the application. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)" along with the appropriate petition fee. Extensions of time are available under 37 CFR 1.136(a).

Please direct further correspondence with respect to this matter to the Commissioner for Patents, Box PCT, Washington, D.C. 20231, and address the contents of the letter to the attention of the PCT Legal Office.



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